The opinion in support of the decision being entered today was *not* written
for publication in and is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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Ex parte KENJI TAGAWA, MASAYUKI KOZUKA, MASATAKA MINAMI,
and TETSUO MAEDA

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Appeal 2007-0992
Application 09/436,656
Technology Center 3600

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Decided: June 11, 2007

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Before WILLIAM F. PATE, III, MURRIEL E. CRAWFORD, and ANTON W.
FETTING, *Administrative Patent Judges.*

FETTING, *Administrative Patent Judge.*

DECISION ON APPEAL

STATEMENT OF CASE

This appeal involves claims 22-24, 26-28 and 43-48, the only claims under
consideration[1] pending in this application. We have jurisdiction over the appeal
pursuant to 35 U.S.C. §§ 6 and 134.

We REVERSE.

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[1] Claims 49-54 are withdrawn from consideration.

1   The Appellants invented a data conversion apparatus in a copyright protection

2   system in which, when audio data is recorded by copying, the audio data is

3   converted to the same data format as that of network distribution data. In this

4   manner, the data format is standardized so as to protect a copyright of non-

5   ciphered audio data as well as ciphered. (Specification 1). An understanding of

6   the invention can be derived from a reading of exemplary claim 22, which is

7   reproduced below.

8   22. A data conversion apparatus for use with an external recording
9   apparatus and an external equipment, and for use in converting data
10   including audio contents to superdistribution format data and
11   outputting the superdistribution format data to be supplied to the
12   external recording apparatus to be recorded therein,

13   said superdistribution format data including said audio contents and
14   attribute information which represents at least a charge condition
15   permitting creation of a copy of the audio contents, and including
16   identification information identifying a user of the data conversion
17   apparatus,

18   said data conversion apparatus comprising:

19   a data transmission/receiving section for transmitting and receiving
20   data to and from the external equipment;

21   a data format judging section for judging whether or not data received
22   by said data transmission/receiving section is of a superdistribution
23   format;

24   an attribute information obtaining section for identifying the audio
25   contents of the data and obtaining attribute information corresponding
26   to the identified audio contents from the external equipment via said
27   data transmission/receiving section;

28   a user ID storage section storing the identification information
29   identifying the user of the data conversion apparatus;

30   a ciphering section ciphering the attribute information obtained from
31   the external equipment and the identification information stored in
32   said user ID storage section;

1   a data format conversion section adding said ciphered attribute
2   information and identification information to the audio contents and
3   thereby converting the audio contents together with the obtained
4   attribute information to the superdistribution data format; and

5   a controller for controlling said data transmission/receiving section,
6   data format judging section, attribute information obtaining section
7   and data format conversion section,

8   wherein, in a case where said data format judging section judges that
9   the received data is not of the superdistribution format, said controller
10   controls said attribute information obtaining section so as to obtain the
11   attribute information corresponding to the audio contents from the
12   external equipment, and wherein said controller controls said data
13   format conversion section so as to convert the audio contents of the
14   received data together with the obtained attribute information into the
15   superdistribution format data, so that the resultant data converted to
16   the superdistribution data format is outputted and supplied to the
17   external recording apparatus,

18   wherein said data transmission/receiving section includes a data read-
19   out portion for reading the data out of a disc medium recorded with
20   the data containing the audio contents and includes a network
21   interface which receives the attribute information corresponding to the
22   audio contents from an external server via a digital network, and
23   wherein said attribute information obtaining section obtains
24   identification information read out of the disc medium and transmits
25   the obtained information to the external server via the digital network
26   and receives attribute information corresponding to the audio contents
27   recorded in the disc medium identified by the identification
28   information from the external server.

29

30   This appeal arises from the Examiner's final rejection, mailed April 4, 2005.

31 The Appellants filed a Brief in support of the appeal on June 2, 2006, and the

32 Examiner mailed an Answer to the Appeal Brief on October 5, 2006.

1   PRIOR ART

2   The prior art reference of record relied upon by the Examiner in rejecting the

3   appealed claims is:

4   Imai   US 5,870,467   Feb. 9, 1999

5   REJECTION

6   Claims 22-24, 26-28, and 43-48 stand rejected under 35 U.S.C. § 102(e)[2] as

7   anticipated by Imai.

8

9   ISSUES

10   The Examiner finds that Imai shows a data conversion apparatus 100 with a

11 data transmission/receiving section/means 11; a data format judging section/means

12 3; an attribute information obtaining section/means 4; a user ID storage

13 section/means storing identification information identifying the user of the data

14 conversion apparatus, necessarily present in order to perform the disclosed

15 "authentication"; a ciphering section/means 132 for ciphering the attribute

16 information, necessarily present in order to "protect" the data; a data format

17 conversion section/means 5 for adding the ciphered attribute information and

18 identification information to the audio contents; and, a controller 1. The Examiner

19 further finds that the data transmission/receiving section/means of Imai includes a

20 data read-out portion 6 and a network interface 102. (Answer 4).

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[2] It is unclear why the Examiner does not also reject the claims under paragraph (a) of Section 102 given that Imai's publication date antedates the Nov. 9, 1999 filing date of the instant application. We find no claim for the benefit of an earlier filing date in the record.

1   The Examiner contends that, in making this rejection, the functional language

2   in the claim has been deemed merely intended usage of the invention, and

3   therefore afforded little patentable weight. The Examiner further contends that the

4   apparatus of Imai is inherently capable of performing the recited functions.

5   (Answer 4).

6   The Appellants contend that Imai fails to show

7   • a data format judging section for judging whether or not data received by

8   said data transmission section is of a super distribution data format (Br. 9-

9   10);

10   • an attribute information obtaining section for identifying the audio contents

11   of the data and obtaining attribute information corresponding to the

12   identified audio contents from the external equipment via a data

13   transmission/receiving section (Br. 10-13);

14   • a user ID storage section storing identification information identifying the

15   user of the data conversion apparatus (Br. 13-14);

16   • a ciphering section ciphering the attribute information obtained from the

17   external equipment and the identification information stored in the user ID

18   storage section (Br. 14-15);

19   • a data format conversion section adding said ciphered attribute information

20   and identification information to the audio contents and thereby converting

21   the audio contents together with the obtained attribute information to the

22   super distribution format (Br. 15-16); and

23   • that in a case where the data format judging section judges that the received

24   data is not of the super distribution format, the controller controls the

1   attribute information obtaining section so as to obtain the attribute

2   information corresponding to the audio contents from the external

3   equipment, and wherein the controller controls the data format conversion

4   section so as to convert the audio contents of the received data together with

5   the obtained attribute information into the super distribution format data, so

6   that the resultant data converted to the super distribution data format is

7   outputted and supplied to the external recording apparatus (Br. 16-17).

8   Thus, the issues pertinent to this appeal are whether the rejection of claims 22-

9 24, 26-28, and 43-48 under 35 U.S.C. § 102(e) as anticipated by Imai is proper,

10 and in particular, whether Imai describes the claimed subject matter the Appellants

11 contend is missing.

12

13   FACTS PERTINENT TO THE ISSUES

14   The following Findings of Fact (FF), supported by a preponderance of

15 evidence, are pertinent to the above issues.

16   *Claim Construction*

17   01.   The term "super distribution data" means distribution data ciphered to an

18   AAC (Advanced Audio Coding) format, the ciphering including at least

19   royalty charge attribute information, and for which the data is deciphered

20   by completing the royalty charging process. (Specification 16).

21   *Imai*

22   02.   Imai refers to the super distribution format as an example of a

23   mechanism to prevent unauthorized distribution of data in its Description

24   of the Background Art (Imai, col. 2, l. 54 – col. 3, l. 12).

1   03.   Imai goes on to state that the background art, including the super

2   distribution format, only protects programs, and does not protect pictures

3   and novels, because the program that reads such data can manage the

4   copyright data improperly (Imai, col. 3, ll. 13-26).

5   04.   Imai does not refer to the super distribution format anywhere else, and in

6   particular, makes no reference to it in conjunction with its description of

7   its data protection process.

8   05.   Imai discloses an input/output management apparatus 10 for controlling

9   data input and data output to and from an input/output requesting

10   program 11 (Imai, Fig. 2; col. 8, ll. 15-18).

11   06.   Imai's input/output management apparatus 10 comprises a data

12   input/output request reception unit 1 for receiving data input/output

13   requests from the program 11; a data input unit 2 for entering data into

14   the program 1 via the input/output request reception unit 1; a protected

15   data judgment unit 3 for judging whether each data input entered into the

16   program 11 is a protected data or not; a protected data input recording

17   unit for recording each input of the protected data detected by the

18   protected data judgment unit 3; an output permission judgment unit 5 for

19   judging whether data output from the program 11 requested via the

20   input/output request reception unit 1 is permitted or not according to the

21   input of the protected data recorded in the protected data input recording

22   unit 4; and a data output unit 6 for outputting data from the input/output

23   requesting program 11 which is judged to be permitted by the output

24   permission judgment unit (Imai, Figs. 1, 2 and 25; col. 8, ll. 18-34).

07. The data input/output management apparatus 10 of Imai described above operates according to the flowchart as shown in Fig. 2. In particular, as shown in steps S21 and S22 of Fig. 2, when the input/output requesting program 11 issues a request for data input/output, the input/output request reception unit 1 receives this request, and judges an ID of the request program 11 and a type of the request, i.e., whether the request is for data input or for data output (Imai, col. 8, ll. 39-44).

08. If it is judged at the input/output request reception unit 1 that the received request is a data input request, the data input unit 2 reads out the requested data from the recording medium (Imai, step S23 in Fig. 2; col. 8, l. 65 - col. 9, l. 3).

09. After the requested data has been read by the data input unit 2, the protected data judgment unit 3 then judges whether the requested input data is a protected data or not by examining the header of the data (Imai, step S24 in Fig. 2; col. 9, ll. 9-10).

10. As explained in Imai, the protected data judgment unit 3 of Imai is able to determine whether a piece of data is protected or not based on either (1) the header of the data, (2) the name of the file in which the data is contained, or (3) according to a recording position of the data in a recording medium (Imai, col. 9, ll. 8-16).

11. If the data judgment unit 3 determines that the data is protected, a record of the input is made in the protected data input recording unit 4 by storing an ID of the requesting program 11 in the protected data input recording unit 4 (Imai, step S23 of Fig. 2; col. 9, ll. 42-55).

1   12.   In contrast, if the data is not determined to be protected, then no record

2   is made in the protected data input recording unit 4 (Imai, col. 9, ll. 45-

3   48).

4   13.   Next, the requested data is transferred to the input/output requesting

5   program 11 (Imai, step S26 of Fig. 2; col. 9, ll. 64-65).

6   14.   On the other hand, when a data output request is received at the

7   input/output request reception unit 1, the output permission judgment

8   unit 5 checks whether the ID of the requesting program 11 is stored in

9   the protected data input recording unit 4 (Imai, step S27 of Fig. 2; col.

10   10, ll. 10-16).

11 15.   If the ID is not stored in the protected data input recording unit 4, then

12   the data is output (Imai, step S28 of Fig. 2; col. 10, ll. 16-20).

13 16.   However, if the ID is stored in the protected data input recording unit 4,

14   this implies that the requesting program 11 has previously read protected

15   data (Imai, col. 10, ll. 22-27).

16 17.   Whether Imai's data can be output is based on the type of requested

17   output target. For example, when the requested output target is an

18   output device such as a display device from which the data cannot be

19   directly read by another program, the data output request is permitted

20   and the requested data is output to the specified output target (Imai, steps

21   S29, S30 and S31 of Fig. 2; col. 10, ll. 27-30).

22 18.   Conversely, if it is determined that the output target is not a display

23   device, the data output request is refused because there is a possibility

1   that protected data will be duplicated (Imai, step S31 of Fig. 2; col. 10,

2   ll. 31-33).

3   19.   In Imai, for a requesting program 11 that has not read any form of

4   protected data, the data input/output management apparatus permits data

5   output from the program 11 without any restriction (Imai, col. 10, ll. 37-

6   39).

7   20.   Conversely, for a requesting program that has read at least one piece of

8   protected data, a data output is permitted only to an output target such as

9   a display device, and a data output to any other target is prohibited (Imai,

10   col. 10, ll. 39-43).

11   21.   Imai's data input/output management apparatus 10 is able to eliminate

12   the possibility of protected data being duplicated, without limiting data

13   output operations for any program 11 that has not read any protected

14   data (Imai, col. 10, ll. 43-46).

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17   PRINCIPLES OF LAW

18   *Claim Construction*

19   We begin with the language of the claims. The general rule is that terms in

20   the claim are to be given their ordinary and accustomed meaning. *Johnson*

21   *Worldwide Assocs. v. Zebco Corp.*, 175 F.3d 985, 989, 50 USPQ2d 1607, 1610

22   (Fed. Cir. 1999). In the USPTO, claims are construed giving their broadest

23   reasonable interpretation.

24   [T]he Board is required to use a different standard for construing
25   claims than that used by district courts. We have held that it is error

1   for the Board to "appl[y] the mode of claim interpretation that is used
2   by courts in litigation, when interpreting the claims of issued patents
3   in connection with determinations of infringement and validity." *In re*
4   *Zletz, 893 F.2d 319, 321, 13 USPQ2d 1320[, 1322] (Fed. Cir. 1989)*;
5   accord *In re Morris, 127 F.3d 1048, 1054, 44 USPQ2d 1023 (Fed.*
6   *Cir. 1997)* ("It would be inconsistent with the role assigned to the
7   PTO in issuing a patent to require it to interpret claims in the same
8   manner as judges who, post-issuance, operate under the assumption
9   the patent is valid."). Instead, as we explained above, the PTO is
10   obligated to give claims their broadest reasonable interpretation
11   during examination.

12 *In re Am. Acad. of Sci. Tech Ctr.*, 367 F.3d 1359, 1369, 70 USPQ2d 1827, 1834

13 (Fed. Cir. 2004).

14

15   *Anticipation*

16   "A claim is anticipated only if each and every element as set forth in the claim

17 is found, either expressly or inherently described, in a single prior art reference."

18 *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d

19 1051, 1053 (Fed. Cir. 1987). "When a claim covers several structures or

20 compositions, either generically or as alternatives, the claim is deemed anticipated

21 if any of the structures or compositions within the scope of the claim is known in

22 the prior art." *Brown v. 3M*, 265 F.3d 1349, 1351, 60 USPQ2d 1375, 1376 (Fed.

23 Cir. 2001). "The identical invention must be shown in as complete detail as is

24 contained in the . . . claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226,

25 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as

26 required by the claim, but this is not an *ipsissimis verbis* test, i.e., identity of

27 terminology is not required. *In re Bond*, 910 F.2d 831, 832, 15 USPQ2d 1566,

28 1567 (Fed. Cir. 1990).

1   ANALYSIS

2   *Claims 22-24, 26-28, and 43-48 rejected under 35 U.S.C. § 102(e) as anticipated*

3   *by Imai.*

4   With regard to the data format judging element, the protected data judgment

5   unit 3 is responsible for determining whether a piece of data is protected or not, by

6   examining, for example, the header of the data to determine whether the header is

7   of a prescribed format (FF10). Thus, while the protected data judgment unit 3 of

8   Imai is able to determine whether data is protected or not, the protected data

9   judgment unit 3 is not disclosed as being able to judge whether or not data is of a

10 super distribution format. The Examiner has taken the position that the data

11 judgment unit 3 of Imai is inherently capable of judging whether or not data is of a

12 super distribution format, but has provided no evidence, or even a logical argument

13 to support this assertion. The super distribution format is a specific, not a generic,

14 format (FF01). Thus, some program that recognizes how to find and create data in

15 this format is necessary to perform this claim element, and the Examiner has not

16 shown that Imai describes such a program with its disclosed process. Thus, we do

17 not find that the Examiner has shown that Imai describes the claimed format

18 judging element.

19   With regard to the audio attribute finding element, the Examiner has taken the

20 position that the protected data input recording unit 4 of Imai corresponds to the

21 attribute information obtaining section as claimed. In other words, the Examiner

22 has taken the position that the protected data input recording unit 4 of Imai is

23 inherently capable of identifying audio contents of the data and obtaining attribute

24 information corresponding to the identified audio contents from the external

25 equipment via a data transmission/receiving section (Answer 9).

1   Based on the description of the protected data input recording unit 4 (FF11-

2   FF16), it is clear that while the protected data input recording unit 4 of Imai is

3   capable of storing an ID of the requesting program 11 if it is determined that the

4   data input to the data input unit 2 is protected, there is absolutely no disclosure in

5   Imai that the protected data input unit 4 of Imai is inherently capable of identifying

6   audio contents of the data and obtaining attribute information corresponding to the

7   identified audio contents from external equipment via a data transmission/receiving

8   section. Presumably, the Examiner is contending that audio data must inherently

9   be found to be played. However, Imai makes no reference to playback of the data,

10   and makes no reference to finding audio data. Thus, we do not find that the

11   Examiner has shown that Imai describes the claimed audio attribute finding

12   element.

13   With regard to the user ID identifying claim element, Imai relies on an ID to

14   determine whether to output protected data (FF14-16). The Examiner contends

15   that the claimed subject matter is sufficiently broad to read on this ID. We note

16   that there is no lexicographic definition of a user in the Specification, and that the

17   program that is running may be construed as an alias for the person operating the

18   program. Thus, we find that the Appellants have not shown that the Examiner

19   erred in finding that Imai describes the claimed user ID element.

20   With regard to the claimed ciphering element, Imai describes writing data in a

21   protected form (FF11). This protected form is ciphered data. However, the

22   claimed subject matter ciphers the attribute data that identifies the audio contents

23   in the data. As we found, *supra*, Imai does not describe such audio attribute data.

24   Thus, we do not find that the Examiner has shown that Imai describes the claimed

25   audio attribute ciphering element.

1   With regard to the claimed data format conversion element, the Examiner has

2   taken the position that the output permission judgment unit 5 corresponds to the

3   data format conversion unit as claimed. In other words, the Examiner has taken the

4   position that the output permission judgment unit 5 of Imai is inherently capable of

5   adding ciphered attribute information and identification information to audio

6   contents and thereby converting the audio contents together with the obtained

7   attribute information to the super distribution format (Answer 4, 11). The

8   Examiner has provided no evidence, or even a logical argument to support this

9   assertion, other than to assert that audio content of a CD are data in a disc medium,

10   and that recording in super distribution format is one of Imai's disclosed intended

11   purposes. The super distribution format is a specific, not a generic, format (FF01).

12   Thus, some program that recognizes how to find and create data in this format is

13   necessary to perform this claim element, and the Examiner has not shown that Imai

14   describes such a program with its disclosed process. Although, as the Examiner

15   asserts, Imai does describe the super distribution format, this is described as an

16   alternative to, rather than part of, Imai's disclosed process (FF0-04). Thus, we do

17   not find that the Examiner has shown that Imai describes the claimed format

18   judging element.

19   With regard to the claimed element that in the case where said data format

20   judging section judges that the received data is not of the super distribution format,

21   a controller converts the audio contents of the received data together with the

22   obtained attribute information into the super distribution format data, the Examiner

23   contends that the attribute information obtaining section/means 4 of Imai indeed

24   performs the steps of "identifying," as in ascertaining the origin, nature, or

25   definitive characteristics of, the audio contents of the data. The Examiner further

14

1   bases this contention on the assertion that the device necessarily ascertains and

2   determines the nature of the data, because the data is digital data in a recognizable,

3   coherent, useable format, as opposed to random background noise. The Examiner

4   further contends that "obtaining" attribute information, e.g., the ID of the

5   file/dataset, etc., corresponding to the identified audio contents (the file/dataset)

6   from the external equipment via a data transmission/ receiving section arises

7   because the device necessarily sends and receives data, and thus, is inherently

8   capable of transmitting and receiving data via a data transmission/receiving

9   section).

10   The Examiner does not contend that Imai shows that, as claimed in the present

11   application, where the received data is not of the super distribution format, the

12   controller obtains the attribute information corresponding to the audio contents

13   from the external equipment, and converts the audio contents of the received data

14   together with the obtained attribute information into the super distribution format

15   data, so that the resultant data converted to the super distribution data format as

16   claimed. The super distribution format is a specific, not a generic, format (FF01).

17   Thus, some program that recognizes how to determine whether data is in this

18   format, and find and create data in this format is necessary to perform this claim

19   element, and the Examiner has not shown that Imai describes such a program with

20   its disclosed process. Further, Imai preserves the protection or lack thereof status

21   of the input data, rather than converting unprotected data to protected as claimed

22   (FF17-21).

23   Thus, we do not find that the Examiner has shown that Imai describes the

24   claimed element that in the case where said data format judging section judges that

25   the received data is not of the super distribution format, a controller converts the

1   audio contents of the received data together with the obtained attribute information

2   into the super distribution format data.

3

CONCLUSIONS OF LAW

5   From the above facts and analysis, we conclude that the Examiner erred in

6   finding the claimed data format judging, attribute information obtaining, ciphering,

7   and data format conversion sections, and the claimed operation of the controller in

8   a case where the data format judging section judges that the received data is not of

9   the super distribution format to be shown by Imai. Therefore, we conclude that the

10   rejection of claims 22-24, 26-28, and 43-48 under 35 U.S.C. § 102(e) as

11   anticipated by Imai is erroneous, and in particular that Imai fails to anticipate all of

12   the elements of the claimed subject matter.

13   Accordingly we do not sustain the Examiner's rejection of claims 22-24, 26-28,

14   and 43-48 under 35 U.S.C. § 102(e) as anticipated by Imai.

15

DECISION

17   To summarize, our decision is as follows:

18   • The rejection of claims 22-24, 26-28, and 43-48 under 35 U.S.C. § 102(e) as

19   anticipated by Imai is not sustained.

REVERSED

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